

Page 8
U.S. patent application No. 09/776,729

REMARKS/ARGUMENTS

Response to the anticipation and obviousness rejections

Applicant has reviewed and considered the Office Action and the cited references mailed July 9th, 2003, and appreciates the Examiner's indication of allowable subject matter.

The Examiner has rejected claims 11-13 under 35 U.S.C. 112 second paragraph. Claim 11 has been amended to overcome this rejection. In particular claim 11, has been amended to clarify the connection between the groove on the protuberance and the channel. This connection or communication between the groove and the protuberance is shown by way of example in FIG. 6 of the present application.

Applicant has also noted that claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by either one of the following documents: SIMMONS (US 4,481,690); BLANK et al (US 4,979,300); KAYE (US 4,914,776); and ROCHE et al. (US 5,996,231); claim 1 being also rejected under 35 U.S.C. 103(a) as being unpatentable over HARDY et al. (US 5,850,663) in view of WOODNORTH et al. (US patent application No. 09/833,095).

In response thereto, claim 4 is cancelled without prejudice or disclaimer; independent claim 1 has been amended, the subject matter of former claim 4 being introduced therein with added limitations; and independent claim 20 has also been amended in a similar manner. As a result, claims 1-3 and 5-20 are pending in the present application. The above-mentioned rejections are respectfully traversed for the following reasons:

Page 9
U.S. patent application No. 09/776,729

The present invention as now better defined in independent claim 1 (and similarly for independent claim 20) is directed to:

"1. In a drywall knife, said drywall knife comprising:

a handle having an elongated inner core comprising a longitudinal axis, a transverse axis, a front end, a rear end and first and second opposite surfaces extending from the rear end to the front end of the inner core along the longitudinal axis thereof; and

a blade securely mounted to the front end of the inner core;

the improvement wherein:

the inner core of the handle comprises rows of recesses (21) extending along the first surface (15) of the inner core (5), each of said recesses (21) having an opening facing said first surface so as to reduce the overall weight of the drywall knife (1), said recesses (21) further defining a set of intersecting ribs (62) shaped, positioned and sized so as to ensure rigidity of the handle (3) while maintaining said reduced overall weight of the drywall knife (1), and

said inner core further comprises a lid (23) hingedly mounted to the first surface (15) of the inner core (5), said lid (23) being positioned and sized to be folded about an axis parallel to the longitudinal axis (7) of the inner core (5) so as to cover said rows of recesses (21), the inner core (5) with the lid in folded position being covered with a covering material (51) so as to facilitate hand gripping of the drywall knife (1)."

(underlined and reference numbers have been added by us herein for sake of better explanation and argumentation only)

It is respectfully submitted that amended independent claim 1 (and similarly independent claim 20) defines distinctively and in explicit terms the subject matter of the invention and that the subject matter clearly distinguishes itself from the references, and more particularly over the cited references. The

Page 10
U.S. patent application No. 09/776,729

various innovative features of the present invention have been underlined and referenced above and are supported by the text and figures of the present application as originally filed. In support of this contention, please refer to page 10, lines 4-17, of the present application and the figures thereof, more particularly Figure 5. Thus, it is respectfully submitted that no new matter has been introduced with the present amendment.

An important advantage resulting from these components and features of the present invention, as now better defined in independent claims 1 and 20, results in the fact that once the drywall knife is assembled, it looks like a drywall knife having a completely "full" handle, as better shown in Figure 1 of the present application, and it also provides substantially the same mechanical properties, in terms of strength and rigidity, than that of a drywall knife with a "full" handle (see page 10, lines 9-17 of the present application), but with the noticeable improvement that it offers a substantially reduced overall weight as a result of the rows of recesses, and corresponding intersecting ribs defined by said recesses, thereby providing an inherently lightweight tool (see for example from page 10, line 29, to page 11, line 1, of the present application), thereby enabling a more ergonomic and less strenuous handling of the tool (i.e. much lighter tool), without compromising the mechanical integrity thereof, thanks to the presence of the ribs defined by the rows of recesses.

As aforementioned, the above-discussed components and features are believed to be important innovative aspects of the invention and thus, independent claim 1, and similarly, independent claim 20, have been amended to better highlight them.

As may now be appreciated, when contrasting the present invention as now defined in independent claim 1 (and similarly in independent claim 20), with the references, SIMMONS (US 4,481,690), BLANK et al. (US 4,979,300),

Page 11
U.S. patent application No. 09/776,729

KAYE (US 4,914,776), ROCHE et al. (US 5,996,231), HARDY et al. (US 5,850,663), and WOODNORTH et al. (US patent application No. 09/833,095) do not teach, illustrate, or even suggest to have a drywall knife comprising a) rows of recesses (i.e. a plurality of recesses) extending along a first surface of a handle of the drywall knife; b) said recesses defining a set of intersecting ribs shaped, positioned and sized so as to ensure rigidity of the handle while maintaining a reduced overall weight of the drywall knife (as supported in page 10, lines 4-17 of the present application); c) a lid foldable about an axis parallel to the longitudinal axis of the inner core of the handle so as to cover said rows of recesses; and d) the inner core with the lid in folded position being covered with a covering material so as to facilitate hand gripping of the drywall knife (thereby concealing the lid and rows of recesses for a seemingly "full-handle" drywall knife).

In fact, the references cited teach away from the present invention, in that, for example, SIMMONS (US 4,481,690) teaches a keycase with a single "recess" as means for retaining keys in said compartment or recess 58 (see Figure 10 and column 2, lines 26-27), thus for storing applications. SIMMONS is silent on using a plurality of recesses and corresponding ribs for reducing the overall weight of the keycase while maintaining the mechanical integrity thereof. As a matter of fact, it is respectfully submitted that the single recess of the SIMMONS keycase causes the compartment to be substantially weakened, and thus less susceptible to withstand torsional and bending loads, because it does not comprise ribs as is the case with the present invention. Moreover, BLANK et al. (US 4,979,300), KAYE (US 4,914,776), ROCHE et al. (US 5,996,231), HARDY et al. (US 5,850,663), and WOODNORTH et al. (US patent application No. 09/833,095) teach away from the present invention as now defined in amended claims 1 and 20 in that their apparatus comprise "recesses" used for gripping applications, and thus these recesses must be left unexposed once the devices or tools are assembled, unlike the present

Page 12
U.S. patent application No. 09/776,729

invention where once the drywall knife is assembled, the lid and rows of recesses are covered with a covering material so as to conceal said lid and rows of recesses for a seemingly "full-handle" drywall knife. Moreover, these references are silent on using a plurality of recesses and corresponding ribs for reducing the overall weight of the tools while maintaining the mechanical integrity thereof.

As it was established in *EverSharp Inc. vs Fisher Pen Company*, 204F supp. 649, 662-3, 132 USPQ 483, 434 (N.D. 111 1961), obviousness by definition is essentially whether or not an unimaginative skilled technician would, in light of the prior art and common general knowledge be led directly and without difficulty to the invention covered by the claims.

In the present case, this very same unimaginative skilled technician would then have added to display skill and ingenuity to not only identify the problems associated with the references, as discussed above, but also come up with corresponding solutions to said problems, which are only taught and claimed in the claims of the present invention.

Thus, the Applicant respectfully submits that such intellectual work or brainstorming has to be inventive and consequently believes that the subject matter of amended independent claim 1 (and similarly, independent claim 20) is non-obvious and thus patentable.

Hence, in view of the above discussed, the Applicant respectfully submits that independent claims 1 and 20 are new and inventive. Since claims 2, 3, and 5-19 depend all directly or indirectly on claim 1 and since claims 2, 3, and 5-19 define distinctively the subject matter which the Applicant regards as his invention, it is believed that these dependent claims are also new and non-obvious, and thus allowable. In this connection, it is submitted that the other

Page 13
U.S. patent application No. 09/776,729

cited references need not be discussed inasmuch as claims 1 and 20 are found allowable.

It is to be understood though that no admission is made nor implied by the present amendment as to the fact that the references cited may be relevant. Indeed, this amendment is made solely to expedite the prosecution of the present application.

In view of the above, it is respectfully submitted that the present application is in a condition for allowance, reconsideration of the present application and a favourable response are respectfully requested.

RESPECTFULLY SUBMITTED

Panfilli et al

William Collard

William C. Collard 38,411
Edward R. Freedman 26,048
Elizabeth Collard Richter 35,103
Frederick J. Dorchak 29,298
Edward J. Callahan 46,594

COLLARD & ROE, P.C.
1011 Northern Boulevard
Roslyn, New York 11576
(516) 365-9802
Enclosures:

Attorneys for Applicant

CERTIFICATE OF FACSIMILE TRANSMISSION

Fax No. 703-672-9310

I hereby certify that this correspondence is being sent by facsimile transmission to the U.S.P.T.O. to Patent Examiner Shay Balsis at Group No.1744, to 1-
703-872-9310 on December 09, 2003.

William C. Collard
William C. Collard